

REMARKS

The present application was filed on November 3, 2000 with claims 1-10. Claims 1-10 are currently pending in the application. Claims 1, 2, 3 and 7 are the independent claims.

Claims 1 and 2 stand rejected under 35 U.S.C. §112, second paragraph, as indefinite.

Claims 1-10 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,671,700 (hereinafter “Creemer”) in view of U.S. Patent No. 6,633,924 (hereinafter “Wu”).

In this response, Applicant amends the specification and claims to correct minor errors of a typographical nature, and traverses the §112 and §103(a) rejections.

Applicant respectfully requests reconsideration of the present application in view of the above amendments and the following remarks.

With regard to the §112 rejection, the Examiner argues that claims 1 and 2 are “replete with grammatical and idiomatic errors.” Applicant respectfully disagrees. These claims are believed to be clear and readily understandable. They are not “generally narrative” and have not been translated from a foreign language, as alleged by the Examiner. For example, claims 1 and 2 each recite a computing system comprising a computer application data file, a computer application send file and a computer application read file. In an illustrative embodiment of the invention, described in conjunction with FIG. 1 of the drawings, examples of these files can be seen as the files denoted A_data.dat, A_data.snt and A_data.red, respectively. See the specification at page 5, line 20, to page 6, line 21. The claim language is entirely consistent with, and supported by, the language in the specification describing the illustrative embodiment of FIG. 1. Accordingly, the §112 rejection is believed to be improper, and should be withdrawn.

With regard to the §103(a) rejection, the Manual of Patent Examining Procedure (MPEP), Eight Edition, August 2001, §706.02(j), states as follows with regard to the burden that the Examiner must meet in order to establish a proper §103(a) rejection:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest

all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Applicant respectfully submits that the Examiner has failed to meet one or more of the above-noted basic criteria, and a proper *prima facie* case of obviousness has therefore not been established. More specifically, Applicant submits that the Creemer and Wu references, even if assumed to be combinable, fail to "teach or suggest all the claim limitations." Further, Applicant submits that there is insufficient motivation to combine Creemer and Wu, or to modify their collective teachings to meet the claim limitations.

Each of the independent claims 1, 2, 3 and 7 recites at least a computer application data file, a computer application send file and a computer application read file. The Examiner argues that such an arrangement of files is shown in the combined teachings of Creemer and Wu. Applicant respectfully disagrees.

In Creemer, information is shared between a host computer system and a peripheral computer system. More specifically, "a plurality of conduit programs running simultaneously on the host computer system synchronize information between the two computer systems" (Creemer, column 2, line 65, to column 3, line 2). The conduit programs "initiate time multiplex transfers" across "a single communication link between the two computer systems" (Creemer, column 3, lines 2-8). One skilled in the art would immediately recognize that this type of conduit program based time multiplex information transfer is entirely distinct from the claimed arrangements involving application programs reading from or writing to at least a computer application data file, a computer application send file and a computer application read file. In formulating the §103(a) rejection, the Examiner acknowledges the deficiencies of Creemer by attempting to apply a combination of Creemer and Wu to the claims.

However, the Wu reference fails to supplement the deficiencies of Creemer in this regard. Wu, like Creemer, fails to teach or suggest application programs reading from or writing to at least a computer application data file, a computer application send file and a computer application read file, as recited in the claims. Instead, Wu teaches an arrangement involving the use of a synchronization manager that interacts with interface components associated with respective

application programs. See Wu at, for example, column 1, line 58, to column 2, line 43. There is no teaching or suggestion in Wu regarding reading from or writing to a computer application send file and a computer application read file as claimed. Wu not only fails to teach or suggest this type of file structure, it actively teaches away from it by teaching to use a synchronization manager in conjunction with interface components associated with respective applications.

Accordingly, it is believed that the collective teachings of Creemer and Wu fail to meet the limitations of the claims.

Applicant further submits that the Creemer and Wu references are not combinable in the manner urged by the Examiner.

The Federal Circuit has stated that when patentability turns on the question of obviousness, the obviousness determination “must be based on objective evidence of record” and that “this precedent has been reinforced in myriad decisions, and cannot be dispensed with.” In re Lee, 277 F.3d 1338, 1343 (Fed. Cir. 2002). Moreover, the Federal Circuit has stated that “conclusory statements” by an examiner fail to adequately address the factual question of motivation, which is material to patentability and cannot be resolved “on subjective belief and unknown authority.” Id. at 1343-1344.

In the Office Action at page 4, last paragraph, the Examiner argues that one skilled in the art would be motivated to combine Creemer and Wu because “Creemer indicates the flow charts [sic] of how system determine [sic] the communication established between two computer systems.” Applicant submits that this statement, and the remaining portion of the last paragraph on page 4 of the Office Action, fail to provide sufficient objective evidence of motivation to combine Creemer and Wu. For example, the Examiner fails to address how one skilled in the art would be motivated to combine two entirely different synchronization arrangements, namely, the one in Creemer involving use of a plurality of conduit programs running simultaneously on a host computer system for initiating time multiplexed transfers, and the one in Wu involving the use of a synchronization manager that interacts with interface components associated with respective application programs. It is not clear how these two systems could be combined to produce a workable system, or why one would be motivated to combine them given that each purports to provide a complete solution to the synchronization problem. Moreover, each of these two references teaches away from the claimed

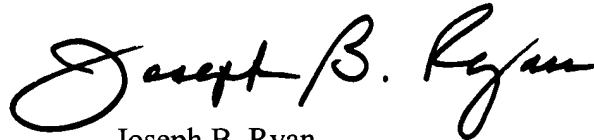
arrangements comprising application send files and application read files, by teaching synchronization arrangements which do not involve the use of such files.

It is therefore believed that a *prima facie* case of obviousness has not been established for independent claims 1, 2, 3 and 7.

Dependent claims 4-6 and 8-10 are believed allowable for at least the reasons identified above with regard to their respective independent claims.

In view of the above, Applicant believes that claims 1-10 are in condition for allowance, and respectfully requests the withdrawal of the §112 and §103(a) rejections.

Respectfully submitted,

A handwritten signature in black ink that reads "Joseph B. Ryan". The signature is written in a cursive style with a large, stylized initial "J".

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